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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/726,520	12/04/2003	Young-Hoon Kim	1793.1050	7202
21171	7590	09/19/2007		
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			EXAMINER GILLIS, BRIAN J	
			ART UNIT 2141	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

mn

<b>Office Action Summary</b>	<b>Application No.</b> 10/726,520	<b>Applicant(s)</b> KIM, YOUNG-HOON	
	<b>Examiner</b> Brian J. Gillis	<b>Art Unit</b> 2141	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 December 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>See Continuation Sheet</u> . | 6) <input type="checkbox"/> Other: _____  |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :10132004, 03142005, and 05172005.

## **DETAILED ACTION**

### ***Claim Objections***

Claim 11 is objected to because of the following informalities: The claim recites "The method as set forth in claim 3". Claim 3 is directed towards an apparatus. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 2, and 5-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the degrees of importance" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim 8 recites the limitation "the degrees of importance" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 9 recites the limitation "the respective e-mails" in line 2. There is insufficient antecedent basis for this limitation in the claim.

As for claims 2, 5-7, 9, and 10 which claim dependency from independent claims 1 and 8, these claims are also rejected under 35 U.S.C. 112, second paragraph for insufficient antecedent basis per the rationale of claims 1 and 8.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8 and 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et al (US Patent #5,694,616) in view of Silverbrook et al (US Patent #6,816,274).

Claim 1 discloses a method of outputting e-mails according to the degrees of importance of the e-mails in an e-mail facsimile machine that sends and/or receives e-mails, comprising: determining the degrees of importance of the e-mails; receiving the e-mails whose degrees of importance are determined; separating the received e-mails based upon the degrees of importance; and printing the e-mails whose degrees of importance are separated into groups in accordance with the degrees of importance. Johnson et al teaches a sender assigns a degree of importance to the message (figure 2, #215-245 and column 3, line 62 – column 4, line 17), emails are received with a determined importance (figure 3, #300-310 and column 4, lines 18-26), and the emails are sorted (figure 3, #310-315 and column 4, lines 23-30). It fails to teach printing the e-mails whose degrees of importance are separated into groups in accordance with the degrees of importance. Silverbrook et al teaches printing the email based on the importance (column 48, lines 59-67).

Johnson et al and Silverbrook et al are analogous art because they are both related to the delivery of email.

At the time of the invention it would have been obvious to a person of ordinary skill in the art to use the print feature in Silverbrook et al with the system in Johnson et al because high priority messages may be printed and viewable upon receipt while low priority messages are able to be stored for later retrieval (Silverbrook, column 48, lines 43-49).

Claim 2 discloses the method as set forth in claim 1, wherein printing the e-mails further comprises: displaying information of the e-mails whose degrees of importance are separated into groups in accordance with the degrees of importance of the e-mails. Johnson et al further teaches the emails with high priority are displayed at the top of the list of received messages (figure 3, #320-325 and column 4, lines 35-40).

Claim 3 discloses an apparatus to output e-mails according to degrees of importance of the e-mails in an e-mail facsimile machine that sends and/or receives e-mails, comprising: a degree of importance determination unit to determine degrees of importance of e-mails, and to output the e-mails whose degrees of importance are determined; an e-mail sending and receiving unit to send and to receive the e-mails whose degrees of importance are determined; a degree of importance separation and process unit to separate the e-mails received from the e-mail sending and receiving unit into groups of varying degrees of importance, and to output the e-mails whose degrees of importance are separated into groups; and a degree of importance separation and print unit to print the e-mails whose degrees of importance are separated into groups in

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accordance with the degrees of importance. Johnson et al teaches a sender assigns a degree of importance to the message (figure 2, #215-245 and column 3, line 62 – column 4, line 17), emails are received with a determined importance (figure 3, #300-310 and column 4, lines 18-26), and the emails are sorted (figure 3, #310-315 and column 4, lines 23-30). It fails to teach a degree of importance separation and print unit to print the e-mails whose degrees of importance are separated into groups in accordance with the degrees of importance. Silverbrook et al teaches printing the email based on the importance (column 48, lines 59-67).

Johnson et al and Silverbrook et al are analogous art because they are both related to the delivery of email.

At the time of the invention it would have been obvious to a person of ordinary skill in the art to use the print feature in Silverbrook et al with the system in Johnson et al because high priority messages may be printed and viewable upon receipt while low priority messages are able to be stored for later retrieval (Silverbrook, column 48, lines 43-49).

Claim 4 discloses the apparatus as set forth in claim 3, further comprising: a degree of importance separation and display unit to display information regarding the e-mails whose degrees of importance are separated in accordance with the degrees of importance. Johnson et al further teaches the emails with high priority are displayed at the top of the list of received messages (figure 3, #320-325 and column 4, lines 35-40).

Claim 5 discloses the method as set forth in claim 1, wherein the degrees of importance of the e-mails are predetermined. Johnson et al further teaches the priority is predetermined by the sender prior to receipt by the receiver (column 3, lines 43-52).

Claim 6 discloses the method as set forth in claim 1, printing the e-mails comprises: saving the received e-mails. Silverbrook et al further teaches the emails are saved indefinitely if not flagged to be deleted upon receipt (column 48, lines 59-67).

Claim 7 discloses the method as set forth in claim 1, wherein the printing of the e-mails in accordance with the degrees of importance comprises printing the e-mails to separate bins according to the degrees of importance. Silverbrook et al further teaches the emails may be stored in separate folders based on certain criteria (column 48, lines 50-58).

Claim 8 discloses a method of sorting and outputting e-mails in an e-mail facsimile machine that sends and/or receives emails according to assigned degrees of importance, comprising: determining the degrees of importance of each e-mail based on the assigned degrees of importance of the e-mails; receiving the e-mails with determined degrees of importance; separating the degrees of importance of the e-mails; and outputting the e-mails in accordance with the degrees of importance. Johnson et al teaches a sender assigns a degree of importance to the message (figure 2, #215-245 and column 3, line 62 – column 4, line 17), emails are received with a determined importance (figure 3, #300-310 and column 4, lines 18-26), and the emails are sorted (figure 3, #310-315 and column 4, lines 23-30). It fails to teach outputting the e-mails in

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accordance with the degrees of importance. Silverbrook et al teaches printing the email based on the importance (column 48, lines 59-67).

Johnson et al and Silverbrook et al are analogous art because they are both related to the delivery of email.

At the time of the invention it would have been obvious to a person of ordinary skill in the art to use the print feature in Silverbrook et al with the system in Johnson et al because high priority messages may be printed and viewable upon receipt while low priority messages are able to be stored for later retrieval (Silverbrook, column 48, lines 43-49).

Claim 10 discloses the method as set forth in claim 2, wherein the displaying of the information regarding the e-mails comprises: sequentially arranging the information regarding the e-mails according to the degrees of importance of the e-mails. Johnson et al further teaches the high priority messages are listed at the top of the list (column 4, lines 26-40).

Claim 11 discloses the method as set forth in claim 3, wherein the degree of importance separation and print unit outputs printing signals of the e-mails corresponding to the degrees of importance. Silverbrook et al further teaches messages are printed based on the priority level (column 48, lines 59-67).

Claim 12 discloses an apparatus to sort and output e-mails in an e-mail facsimile machine, comprising: a degree of importance determination unit to determine degrees of importance of the e-mails, and to output the e-mails; an e-mail sending and receiving unit to send and to receive the e-mails whose degrees of importance are determined; a

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degree of importance separation and process unit to sort the e-mails into groups of varying degrees of importance, and to output the e-mails; and a degree of importance separation and print unit to output the e-mails in accordance with the degrees of importance. Johnson et al teaches a sender assigns a degree of importance to the message (figure 2, #215-245 and column 3, line 62 – column 4, line 17), emails are received with a determined importance (figure 3, #300-310 and column 4, lines 18-26), and the emails are sorted (figure 3, #310-315 and column 4, lines 23-30). It fails to teach a degree of importance separation and print unit to output the e-mails in accordance with the degrees of importance. Silverbrook et al teaches printing the email based on the importance (column 48, lines 59-67).

Johnson et al and Silverbrook et al are analogous art because they are both related to the delivery of email.

At the time of the invention it would have been obvious to a person of ordinary skill in the art to use the print feature in Silverbrook et al with the system in Johnson et al because high priority messages may be printed and viewable upon receipt while low priority messages are able to be stored for later retrieval (Silverbrook, column 48, lines 43-49).

Claim 13 discloses the apparatus as set forth in claim 12, wherein the degree of importance separation and print unit outputs the e-mails in accordance with the degrees of importance by displaying information regarding the e-mails in accordance with the degrees of importance. Silverbrook et al further teaches the email is printed if it is a high priority message (column 48, lines 59-67).

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et al (US Patent #5,694,616) in view of Silverbrook et al (US Patent #6,816,274) as applied to claim 8 above, and further in view of Skladman et al (US Patent #6,400,810).

Claim 9 discloses the method as set forth in claim 8, wherein the outputting of the e-mails comprises: generating alarms corresponding to the degrees of importance of the respective e-mails when outputting the e-mails. Johnson et al in view of Silverbrook et al teaches the limitations of claim 8 as recited above. It fails to teach generating alarms corresponding to the degrees of importance of the respective e-mails when outputting the e-mails. Skladman et al teaches of issuing an alert to notify the user when a priority message is received (column 5, lines 26-42 and 65-67).

Johnson et al in view of Silverbrook et al and Skladman et al are analogous art because they are both related to email delivery.

At the time of the invention it would have been obvious to a person of ordinary skill in the art to use the alert feature in Skladman et al with the system in Johnson et al in view of Silverbrook et al because subscribers are alerted quickly of priority messages and prevented from receiving unwanted messages (Skladman, column 2, lines 35-41).

Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rachelson (US Patent #6,157,706) in view of Usami (US PG PUB US2002/0154746) as per the rejection to the related Chinese Patent Application 200310124352 issued February 18, 2005.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Usami (US PG PUB US2002/0154746) teaches automatically categorizing received mail messages. Rachelson (US Patent #6,157,706) teaches enabling a facsimile machine to be an email client. Bates et al (US PG PUB US2003/0014490) teaches a collating table for email.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian J. Gillis whose telephone number is 571-272-7952. The examiner can normally be reached on M-F 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on 571-272-3880. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

*BJG*

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09/13/2007

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Examiner  
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